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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

CROWDER ET AL.

Serial No.: 09/975,642

Filed: October 10, 2001

Atty. File No.: 3123-380

For: "MAGNETIC RECORDING
HEAD PROTECTION"

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

) Group Art Unit: 2651

Technology Center 2600

) Examiner: WATKO, JULIE ANNE

) AMENDMENT AND RESPONSE TO
) RESTRICTION REQUIREMENT

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6-1703
OK

<p>CERTIFICATE OF MAILING</p> <p>I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450</p> <p>ON <u>June 9 2003</u></p> <p>SHERIDAN ROSS P.C.</p> <p>BY: <u>Lor K Brown</u></p>

In an Office Action dated May 13, 2003, the Examiner issued a Restriction Requirement with regard to the above-identified patent application. Specifically, the Examiner states that the application contains claims directed to two distinct inventions. The Examiner identifies the inventions as follows:

Group I: Claims 1-31 and 43-50, drawn to a method for reducing corrosion of a head element during rework operations, and methods for shipping and storing; and,

Group II: Claims 32-42 and 51-63, drawn to an improvement and a subcombination.

The Examiner further states that the inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product; or (2) that the product as claimed can be made by another and materially different process. (MPEP § 806.05(f)). In support of the Examiner's Restriction Requirement, the Examiner further

states that in the present application, the product as claimed can be made by another and materially different process, such as a process not involving a testing step.

Applicants respectfully traverse the Examiner's Restriction Requirement.

The Examiner's reasoning is perplexing. The only testing recited in Applicants' method claims is in dependent Claims 18, 24, 26 and 28. No other method claim recites testing as a claim element. Thus, the Examiner's reliance on a manufacturing process devoid of a testing step has relevance to only four claims. The Examiner's position does not support a restriction requirement with respect to the other claims. If anything, there is a significant overlap in the scope of the apparatus claims and method claims. Many of the product claims contain the same limitations as is found in the method claims. Although a product claim containing process limitations is considered a product claim for purposes of restriction (MPEP § 806.05(f)), for restriction to be proper there must be a serious burden placed on the Examiner by maintaining the two groups of claims in a single application. See MPEP § 803. In the present application, because of the overlapping nature of many claims, the scope of the search to be conducted by the Examiner, as well as the subsequent analysis of the claims in view of the search results, will be nearly identical for both groups of claims. Therefore, there is no burden on the Examiner, let alone a *serious* burden, by maintaining the claims in the same application and restriction is improper.

Applicants submit the Examiner has not sustained her burden of establishing that restriction is proper and, accordingly, respectfully submit that the application should proceed without restriction.

Subject to the above comments and in the event the traverse of the Restriction Requirement is unsuccessful, Applicants conditionally elect to prosecute the method claims of Group I, namely, Claims 1-31 and 43-50.

AMENDMENT

Paragraph 4 of the Office Action identifies potential issues regarding Claims 40-42 and 61-63. Applicants have further noted concerns regarding other claims. Therefore, please amend the above-identified patent application as follows: